

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNARD TICKNER

Appeal 2007-0317
Application 09/944,932
Technology Center 1600

Decided: May 31, 2007

Before TONI R. SCHEINER, DONALD E. ADAMS, and ERIC GRIMES,
Administrative Patent Judges.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claim 1, the only pending claim in this plant application. We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

Claim 1 reads as follows:

1. A new and distinct variety of Euphorbia plant named 'Charam' as described and illustrated.

The Examiner relies on the following evidence to show unpatentability:

United Kingdom Plant Breeder's Grant Identifier No. PBR 03000204 (August 1, 1999) (PBR).¹

The New Royal Horticultural Society Dictionary of Gardening, Vol. 2, p. 245 (eds., Anthony Huxley, et al.).²

Appellant's admitted sale of the Euphorbia plant named 'Charam' in Europe in the United Kingdom as early as April 1, 1998.

The rejection as presented by the Examiner is as follows:

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the PBR.

We affirm.

¹ The record is somewhat confused as to the date of this reference. For clarity we note that the Examiner originally rejected the claims over both the "Breeder's Right [G]rant [Identifier N]umber [PBR] 03000304" published on August 1, 1999 and the Breeder's Right "Application [N]umber 30/204" of January 1, 1998. (August 13, 2002 Office Action 4). The rejection before us on appeal refers to the "Grant" "published on January 1, 1998" (Answer 3). This date is incorrect. The Grant published on August 1, 1999. The August 1, 1999 publication date of the Grant is more than one year prior to Appellant's filing date. Therefore, we find this error to be nothing more than a harmless typographical error.

² The evidence of record does not identify a publication date for this reference. However, the record copy does indicate that this reference was received by the Office's Scientific and Technical Information Center on July 10, 1992.

DISCUSSION

The issue before us is whether evidence of a foreign sale of a claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing that plant, thereby creating a § 102(b) bar. This specific issue was addressed in *In re Elsner*, 381 F.3d 1125, 1128, 72 USPQ2d 1038, 1041 (Fed. Cir. 2004), wherein our appellate reviewing court held in the affirmative. In reaching this conclusion, the *Elsner* court found that

[w]hen a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar. In any event, the inventor is in control of the activities relating to his invention, and avoidance of a bar is accomplished by making a timely filing at the PTO.

Id. at 1129, 72 USPQ2d at 1041.

In *Elsner*, the court found that “the precise focus of the analysis is not whether the foreign sales are themselves § 102(b) prior art, but whether the publication has placed the claimed invention in the possession of the public before the critical date.” *Id.*, at 1129-30, 72 USPQ2d at 1042. In this regard, the *Elsner* court explained that “[t]he foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available.” *Id.*, at 1131, 72 USPQ2d at 1043. In addition, the *Elsner* court explained that “even if the interested public would readily know of the foreign sales, those sales [must] enable[] one of

ordinary skill in the art to reproduce the claimed plants without undue experimentation. Such a determination is critical to the question whether the foreign sales would enable the printed publication.” *Id.*

In the Brief, Appellant’s arguments focused on the rationale in *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) (Br. 12-13). In particular, Appellant asserted that “[t]he court in *In re LeGrice* established a perfectly workable and rational approach for applying the policy and the language of 102(b) to this unique situation” (Br. 12). Appellant’s arguments in the Brief suggested that *Elsner* is not controlling on the issue presented in this appeal. Accordingly, this Panel required Appellant to

clearly state the rule of law which supports Appellant’s position that, in contrast to the holding in *Elsner*, the public use and availability of a plant variety outside of the United States is not material to a determination of the patentability of a plant variety in the United States under 35 U.S.C. § 102(b) . . .

(Order³ 6.) In response, Appellant directed our attention to *LeGrice* (Response to Order 2).

This Panel also required Appellant to “clearly state whether it *is*, or *is not* Appellant’s position that *Elsner* is in conflict with *LeGrice*” and to clearly explain the basis for the position taken (Order 7). In response, Appellant stated that “Appellants [sic] believe that the holdings of *Elsner* are in conflict with *LeGrice*” (Response to Order 3). In Appellant’s opinion, *LeGrice* “established a perfectly workable and rational approach for applying the policy and the language of 102(b) to the unique situation of plant patents” (*id.*). We are not persuaded by Appellant’s arguments. This

³ Order under 37 C.F.R. § 41.50(d), mailed March 1, 2007.

argument was specifically raised, discussed, and dismissed in *Elsner*. The *Elsner* court found that their holding did not conflict with *LeGrice* which

decided only the narrow issue whether a printed publication of a plant patent that is not enabled is a statutory bar. That decision did not address the manner in which a publication may be enabled, and it did not decide whether other evidence such as the availability of an invention through foreign sales may be considered in determining whether a printed publication enables a skilled artisan to reproduce a claimed plant. In fact, there was no mention of sales in the *LeGrice* opinion. We therefore conclude that *LeGrice* left that issue open, and our decision today is not inconsistent with *LeGrice*.

Elsner, 381 F.3d at 1130, 72 USPQ2d at 1042-43.

THE PRINTED PUBLICATION:

The filing date of Appellant's plant application is August 31, 2001. The Examiner finds that the PBR published on January 1, 1998, which is more than three years prior to Appellant's filing date (Answer 3). The Examiner finds that the PBR application is open to public inspection; and "the Appellant, Breeder and Assignee are all listed on this publication. As a result, one of ordinary skill in the art would have known whom to contact to purchase the plant" (Answer 3). The PBR describes the claimed plant variety, specifically the Euphorbia plant named 'Charam' (Answer 3-4). "The Community Plant Variety Office publishes applications for variety protection. Once the Breeder's Grant is made, the variety and description are entered in the Plant Variety Protection Register" (Answer 3). "The register, grant and published applications are accessible to the public. This information was available on-line as well as in CD-ROM format . . ." prior to Appellant's filing date (Answer 3).

Based on this evidence, the Examiner finds that the PBR “is a ‘printed publication’ under 35 U.S.C. [§] 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981)” (Answer 3). We agree.

Appellant does not dispute that the PBR describes the claimed plant variety. Instead, Appellant asserts that “[t]he Office stated that copies of these documents are not readily obtainable”; and “[i]f these documents are not readily obtainable by the U.S. Patent Office . . . then they would be difficult to obtain by an isolated plant breeder” (Br. 9-10). As discussed above, the Examiner has clearly explained the manner in which the PBR and other information relating to the claimed plant variety were widely disclosed to the public, e.g., the information was available on-line and on CD-ROM (Answer 3). For his part, Appellant offers no evidence to support the assertion that a person of ordinary skill in the art, e.g., an interested plant breeder, would have been unaware of the PBR more than one year prior to Appellant’s filing date. Appellant also fails to provide evidence or argument that the PBR and other information relating to the claimed plant variety were not widely disclosed to the public, including on-line and on CD-ROM. Accordingly, we are not persuaded by Appellant’s assertion.

THE FOREIGN SALE:

Appellant admits that the claimed Euphorbia plant named ‘Charam’ “was sold in [t]he United Kingdom as early as April 1[,] 1998 (page 3 of reply filed October 18, 2002)” (Answer 3; Response to Request for

Information⁴ 2). Appellant notes, however, that “Euphorbia Charam is sold under the trade name Euphorbia Redwing” (Response to Request for Information 2). According to Appellant, “[n]o advertising was undertaken prior to the application date of the [instant] application” (Response to Request for Information 1). However, “Euphorbia Charam was . . . marketed by Notcutts sales force directly to Garden Centers in the United Kingdom after April 1, 1998 under the name Euphorbia Redwing” (Response to Request for Information 2).

Based on this evidence, the Examiner finds that Appellant admitted that the claimed plant variety was sold in the United Kingdom more than one year prior to Appellant’s filing date and that the sale did “not appear to be an obscure or isolated occurrence” (Answer 4). We find that the evidence on this record supports the Examiner’s finding regarding the sale.

Specifically, Appellant’s first appeal, Appeal No. 2004-1268, on the claimed subject matter was remanded to the Examiner to clarify, *inter alia*, the nature of Appellant’s 1998 sale (VACATUR AND REMAND 3 (we “remand the case to the [E]xaminer to determine whether the sales of the claimed plant (1) were ‘an obscure, solitary occurrence that would go unnoticed by those skilled in the art’ . . . ”)). In response, the Examiner entered a Request for Information⁵ (Request) under 37 C.F.R. § 1.105 into the record requesting, *inter alia*, information relating to the sale of the claimed plant variety (Request 3⁶). In response, Appellant asserts that while no advertising was performed prior to the filing date of the instant

⁴ Received May 6, 2005.

⁵ Mailed March 18, 2005.

⁶ This document is not paginated. For clarity, we have assigned consecutive page numbers to this document starting with the cover page as page 1.

application, the claimed plant variety “was sold under name Euphorbia Redwing” starting on April 1, 1998 and was marketed “to Garden Centers in the United Kingdom after April 1, 1998 under the name Euphorbia Redwing” (Response to Request for Information 1-2). We interpret the sale and marketing before and after April 1, 1998 to include the sale and marketing of the claimed plant variety more than one year prior to Appellant’s filing date.

On March 1, 2007 this Panel entered an Order under 37 C.F.R. § 41.50(d) (Order) into the record requiring Appellant to clearly explain, *inter alia*, “how the evidence on this record establishes that the admitted sale of the claimed plant should be considered ‘an obscure solitary occurrence that would go unnoticed by those skilled in the art’” (Order 7-8). In response, Appellant asserted that “[i]t is unknown if one skilled in the art who is interested in reproducing Euphorbia Charam would have known to go to the United Kingdom and purchase plants under the different name of Redwing in order to replicate the plant” (Response to Order under 37 C.F.R. § 41.50(d)⁷ (Response to Order) 5).

Appellant asserts that since the claimed plant was sold under the trade name Redwing a “plant breeder would not find plants for sale under the name of Charam and therefore would not have any plants to replicate” (Response to Order 5; Br. 14). Appellant offers no evidence to support this conjecture. Arguments of counsel cannot take the place of evidence. *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). As the Examiner explains, the PBR lists the inventor,

⁷ Received April 5, 2007.

breeder and assignee name. The breeder is in the business of selling plants. One of ordinary skill in the art could have called the breeder and asked for [a] Charam cultivar. The breeder would have sold the plant explaining that this cultivar was sold under a different name. The fact that Appellant admits to selling the plant sustains this scenario.

(Answer 4-5.) We agree. There is no evidence on the record to suggest that a person of skill in the art could not have obtained the claimed plant variety described in the PBR from the inventor, breeder, or applicant who are all identified on the PBR. Therefore, we find that there is no evidence on this record that the sale of the plant was an obscure, solitary occurrence that would go unnoticed by those skilled in the art.

We recognize Appellant's assertion that “[t]he public use and availability of the subject plant variety outside of the United States is not material to a determination of ‘plant patentability’ of a plant variety in the United states under 102b [sic]” (Br. 10). Because this assertion is contrary to the holding in *Elsner*, we do not find it persuasive.

We recognize Appellant's assertion that “[f]oreign asexually propagatable plant material . . . is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States [and] . . . imposes rigorous importation requirements” (Br. 12). This assertion appears to suggest that the regulations relating to the importation of plant material into the United States would have prevented a person of ordinary skill in the art from obtaining the claimed plant variety prior to the 102(b) date of Appellant's application. Accordingly, this Panel required Appellant to “clearly explain how the evidence on this record establishes that United

States importation requirements would have precluded a person of ordinary skill in the art from obtaining a foreign asexually . . . [propagatable Euphorbia] plant material, as claimed" (Order 7). In response, Appellant asserted that "if one skilled in the art did follow the procedures specified by the Plant Quarantine Act of 1912, they would be adding an additional time period before plants were able to be imported into the United States" (Response to Order 4). While this may be true, we find no evidence on this record to suggest that a person of ordinary skill in the art would not have been able to obtain the claimed plant variety in the United States more than one year prior to Appellant's filing date. Accordingly, we are not persuaded by Appellant's assertion.

REPRODUCTION WITHOUT UNDUE EXPERIMENTATION:

The Examiner explains that "[t]he reproduction of Euphorbia spp. is clearly explained in the New Royal Horticultural Society Dictionary of Gardening on page 245. As a result, one of ordinary skill in the art could have bought the plant and asexually propagated it, thus reproducing the invention without undue experimentation" (Answer 5). Appellant asserts that "propagation of Euphorbia 'Charam' is enhanced by dipping the cuttings [in] warm water prior to insertion" (Response to 41.50(d)). There is, however, no evidence on this record that it would require undue experimentation for a person of ordinary skill in the art to reproduce the claimed plant variety according to the methodology set forth in the New Royal Horticultural Society Dictionary of Gardening. Accordingly, we are not persuaded by Appellant's assertion to the contrary.

SUMMARY:

For the foregoing reasons, we find the facts of record on this record are very different than those in *LeGrice*, and therefore we find that *Elsner* is the controlling law on the issue before us on appeal.

We find that the evidence on this record establishes that a person of ordinary skill in this art would have known of the PBR, the sources available for obtaining the claimed plant variety, and the methodology used to asexually reproduce the claimed plant variety. We find no error in the Examiner's use of secondary references to show that the PBR was enabled.

In re Samour, 571 F.2d 559, 562-63, 197 USPQ 1, 4 (CCPA 1978).

As to the sale of the claimed plant variety under the trade name Redwing, there is no evidence on this record to suggest that a person of ordinary skill in the art would not be able to obtain the claimed plant variety despite its sale under the trade name Redwing. We do not find, and Appellant has not identified, an error in the Examiner's rationale addressing this point. There is no evidence on this record that the sale of the claimed plant variety was an obscure, solitary occurrence that would go unnoticed by those skilled in the art. There is also no evidence on this record that a person of ordinary skill in this art would not be able to reproduce the plant without undue experimentation. As set forth in *Elsner*,

[w]hen a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar.

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Elsner, 381 F.3d at 1129, 72 USPQ2d at 1041.

On reflection, we find that the weight of the evidence falls in favor of the Examiner. Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b).

CONCLUSION

In summary, the rejection of claim 1 under 35 U.S.C. § 102(b) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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